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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.  |
|---|-------------|----------------------|---------------------|-------------------|
| 10/658,778  | 09/10/2003  | Manabu Hayashi       | 117088              | 4066              |
| 25944   | 7590        | 02/13/2009           | EXAMINER            |                   |
| OLIFF & BERRIDGE, PLC<br>P.O. BOX 320850<br>ALEXANDRIA, VA 22320-4850 |             |                      |                     | STOREY, WILLIAM C |
| ART UNIT  |             | PAPER NUMBER         |                     |                   |
| 2625  |             |                      |                     |                   |
| MAIL DATE   |             | DELIVERY MODE        |                     |                   |
| 02/13/2009  |             | PAPER                |                     |                   |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/658,778             | HAYASHI ET AL.      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | WILLIAM C. STOREY      | 2625                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 November 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 13 and 17-27 is/are pending in the application.

4a) Of the above claim(s) 13,17-18 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 13,17-27 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### **Note**

"While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

"[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original)." -MPEP 2114-R1. Therefore, any structurally-equivalent system *capable* of performing the functionality described in a claim would anticipate the claim.

### ***Election/Restrictions***

1. Newly amended claim 13 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Previously, (see previous claim 14), it was claimed that "a reporting unit sends a report of facsimile-forwarding failure by an email to a sender of the email when the facsimile-forwarding of the facsimile-forwarding data was stopped by the forward stopping control unit" such as

disclosed by Fig. 6, Fig. 7 and pg. 13, lines 17-21. However, now claim 13 claims performing a different operation (printing) in response.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 13 (and dependents) is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 18 (and its dependents) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant remarked during the most recent interview that a number of pages as a limit would not correspond to forwarding size upper limit due to the word “size.” In addition, the specification presents the forwarding size upper limit as separate from the forwarding page upper limit and provides no other support for the forwarding size upper limit being based on a number of pages.

2. Claim 18 (and similarly-limited and dependent claims) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Due to the amendments to claim 13, claim 18 now lacks proper written description support. Fig. 2 discusses printing when image size is equal to/less than a forwarding upper limit (see also pg. 7, lines 18-21). Fig. 3, which discloses dealing with image page number equal to/less than a forwarding upper limit, as claimed, does not disclose printing a report in the case that forwarding of the facsimile data stopped by the forward stopping control unit, but rather, splitting image data into predetermined page-number units (see also pg. 7, lines 27-32 and pg. 8, lines 1-2).

3. Claim 19 & 25 (and dependents and similarly-limited claims) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description

requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Claim 19 discusses a receiver whose facsimile data is received and matching this receiver with a destination of an email. The specification talks of matching a destination email address with a destination email address in a forwarding list (pg. 9, lines 9-13). However, please provide written description support for a registered receiver whose facsimile data is received is the destination of the email.

4. Claim 25 (and its dependents) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant claims "a selection unit that selects the facsimile-forwarding destination specified by the facsimile-

forwarding instruction when the first determining unit determines that the facsimile-forwarding destination is instructed by the email and selects the facsimile-forwarding destination corresponding to the receiver registered by the registering unit when the second determining unit determines that the destination of the email is the receiver registered by the registering unit.” However, this wording is contentious. In the specification, it talks of how if a destination is both instructed by email and is registered, the instruction of the email will reign (pg. 12, lines 22-24). However, the wording of this limitation runs counter to the specification. It is possible that a destination be both registered and forwarding instructed by email, or forwarding instruction present in the email and in the forwarding list. Thus, in the case discussed, the facsimile forwarding destination corresponding to receiver registered by the registering unit would not necessarily be “selected” when the second determining unit determines that the destination of the email is the receiver registered by the registering unit.

5. Claim 25 (and similarly-limited and dependent claims) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor’s obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as

the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Please provide written description support for the two separate determining units performing the claimed functions.

6. Claim 19 & 25 (and dependents) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Please provide written description support for the registering unit performing the claimed functions.

7. Claim 25 (and dependents) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Please provide written description support for a registering unit that registers a sender whose email is permitted to be facsimile forwarded in conjunction with the rest of the limitations pertaining to the particular embodiment.

8. Claim 25 (and dependents) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention.

Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. The claim claims "a converting unit that converts the email into facsimile data, the facsimile data including an image data to be transferred to the facsimile machine, when the first determining unit determines that the facsimile-forwarding destination is instructed or when the second determining unit determines that the destination of the email is the receiver." This is contrary to teachings of the specification. Pg. 11, lines 21-22, pg. 12, lines 16-18, fig. 6 prove that the first determining unit determining that the facsimile-forwarding destination is instructed is not sufficient alone to cause the converting of the email into facsimile data (thus, there is a case when the first determining unit determining that the facsimile-forwarding destination is instructed and the converting of the email into facsimile data as claimed does not occur).

9. Claim 25 (and dependents) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is

claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Please provide written description support for the selection unit performing the claimed functions.

10. Claim 25 (and similarly-limited and dependent claims) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. The claim claims that the analyzing unit absolutely obtains a facsimile forwarding instruction from the email. However, pg. 12, lines 3-9 disclose that such claimed absolutely obtained information may actually be

absent, thus, not obtained. Please ensure such types of conditionality throughout the claims.

11. Claim 26 (and dependents) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Please provide written description support for the fourth determining unit performing its newly-amended functions separately from the third determining unit.

12. Claim 27 (and dependents) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the

technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. The applicant claimed that written description support for claim 27 was provided in at least claim 25. Please provide the written description support.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 19 (and similarly-limited and dependent claims) is rejected under 112.

Claim 19 recites the limitation "the sender." There is insufficient antecedent basis for this limitation in the claim. It is disclosed that there is a registering unit that registers senders whose emails are permitted to be facsimile forwarded; however, no particular sender that was registered has been previously defined in the claim.

15. Claim 25 (and similarly-limited and dependent claims) is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is claimed "a first determining unit that determines whether facsimile-forwarding destination is instructed." This is grammatically incorrect. The amendment does not provide the

same limitation as it was previously presented. It is unclear as to what the applicant's intended interpretation was to be.

16. Claim 25 (and similarly-limited and dependent claims) is rejected under 112. Claim 25 recites the limitation "the facsimile-forwarding destination specified by the facsimile-forwarding instruction." There is insufficient antecedent basis for this limitation in the claim. Due to the amendments, no facsimile-forwarding instruction is defined in the claim. A facsimile-forwarding destination may be defined as instructed, but it is unclear as to exactly what "the facsimile-forwarding instruction" is to refer.

17. Claims 25 & 26 (and dependents and similarly-limited claims) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "The facsimile-forwarding destination" is referred to. However, numerous facsimile forwarding destinations are discussed (for example, corresponding to the receiver, selected by the selecting unit, instructed by the email, etc.). It is unclear as to which facsimile-forwarding destination is being referred. For claim 25, "when the first determining unit determines that the facsimile-forwarding destination is instructed or..." with respect to the converting unit, it may be assumed that the facsimile-forwarding destination is the one claimed as instructed by the email. For claim 26, "sends an accumulation report to the facsimile-forwarding destination by facsimile" may be assumed to be the facsimile-forwarding destination corresponding to the receiver.

18. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. The claim does not make sense. It is unclear how to interpret the claim. The claim recites an if statement (if X). Usually an if statement is followed by a then statement (if X, then Y). There is no then statement.

19. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim claims that a facsimile-forwarding destination includes two facsimile-forwarding destinations. This does not make sense.

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 13 & 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufeld et al. (US 5859967), hereinafter referred to as Kaufeld, in view of Eguchi (US 6982803), Miyanaga (US 7009725), and Sekiguchi (US 20020054335).

Regarding claim 13, the claim reads an image communication apparatus for sending a facsimile data to a facsimile machine, the apparatus comprising (the system of Kaufeld is disclosed as capable of sending a facsimile to a facsimile machine (Kaufeld: col. 3, lines 35-42)):

an email receiving unit that receives an email (column 3, lines 31-36. The transmission computer reads on claimed email receiving unit and receives email.); an analyzing unit that analyzes the email received by the email receiving unit (column 3, lines 35-42

discloses the transmission computer checking over the received email, reads on claimed analyzing); a determining unit that determines whether facsimile-forwarding is instructed by the email analyzed by the analyzing unit (column 6, lines 45-48 disclose addressing the email to the destination number of the facsimile machine to which the message is to be delivered. column 3, lines 35-42 disclosed the transmission computer sending the email to a facsimile machine. column 7, lines 13-18 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Figures 4 & 6 disclose the fax number from the email used for the received fax sending. Transmission computer does the converting and analyzing, thus reading on the determining unit in the process in order to glean the fax number.);

a converting unit that converts the email into the facsimile data, the facsimile data including an image data to be transferred to the facsimile machine, if the determining unit determines that the facsimile-forwarding is instructed (As has been discussed above and at column 3, lines 38-42, the transmission computer, reading on claimed converting unit, converts the email into a fax and sends the email to the fax number instructed in the email. Facsimile data is in the conventional manner is sent as image data. Col.8, lines 52-54 discloses the conversion of email into facsimile image data for transmission.);

a setting unit that sets an upper limit for facsimile-forwarding the email (column 8, lines 57-59 discloses the use of a transmit counter. Column 9, lines 9-20 disclose that once the counter exceeds a predetermined number, which reads on claimed upper limit;

the attempts to fax-forward will cease. Fig 8c. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37) and thus, reads on claimed setting unit.);

and a forwarding control unit that conducts facsimile-forwarding of the facsimile data converted by the converting unit to a facsimile-forwarding destination specified by the facsimile-forwarding instruction when the facsimile data converted by the converting unit does not exceed the upper limit set by the setting unit (The transmission computer performs the above and thus, reads on claimed forwarding control unit. Fig. 8c shows the attempt of fax transmission for the process described previously. Fig. 8c shows the fax transmission allowed to proceed if the counter is below the predetermined number, which reads on claimed does not exceed the upper limit. This and the previous disclosures read on preceding limitation.)

However, Kaufeld fails to disclose an upper limit for transmission being a forwarding size limit of facsimile data.

In a similar field of endeavor, Eguchi discloses a facsimile server, electronic mail device, and communication method. The facsimile server is typical for reception of faxes and allows for advance reception of faxes. Sending through a fax server would have been obvious to allow for advance storage, which would save time and allow for greater convenience and management. However, the storage size for holding the fax data is limited (col. 1, 26-31). Considering this issue, Eguchi discloses data size as a forwarding size upper limit of facsimile data (Eguchi discloses a RAM 21, which the capacity of is a designated value, which reads on claimed upper limit based on a data size of data; as disclosed at Figure 2 and column 4, line 15, and column 5, line 2-4.

Eguchi discloses the when the data size for transmission is larger than the designated value, the facsimile server 2 does not receive the electronic mail from the electronic mail box, hence preventing transmission, as opposed to when the data size is smaller and the electronic mail is received as usual, thereby allowing fax transmission, as disclosed at Figure 2 and column 5, lines 4-7, lines 11-16, 22-37.)

Kaufeld disclosed being able to compare an instance (counter value, for example) against a limit (predetermined value (col. 9, lines 6-67)). Based on whether the limit is exceeded, the fax is allowed to proceed or not. Using this same methodology, a limit could similarly be set based on data size, as taught by Eguchi.

However, Eguchi has taught a receiving side checking the initial size of data to be sent. Though the data may be in email format, the system still shows how the data size is able to be compared for fax storage. However, Eguchi did not distinctly show the sending side checking. Though this would be an obvious connection to have a similar process run by the sending side rather than the receiving side accordingly, the examiner provides a reference that shows the idea of a sending side checking, in order to provide further support.

In a similar field of endeavor, Miyanaga discloses a communication control method and system. Miyanaga discloses at col. 1, lines 63-67, col. 2, lines 1-3 that it is determined whether the transmission data amount of image data to be sent to a server from a communication apparatus exceeds the limit capacity of the server before the image data is sent, and that processing (limiting) is performed when the image data exceeds the limit capacity of the server. Though Miyanaga discloses the scenario with

respect to email, the difference with respect to transmission of facsimile data would be insubstantial. In addition, the image data that is checked is the image data from a converted facsimile (col. 3, lines 31-34). The idea of checking reception capacity before transmission could be applied. It would have been obvious to modify the current system by allowing for Kaufeld to check fax server capacity for limiting (Eguchi), but to check before sending (Miyanaga) in order to save a lot of time for the image transmission (col. 1, lines 61-62) that might occur if the data is sent, but not able to be fully received.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaufeld by specifically providing the upper limit being a forwarding size limit of facsimile data, as taught by Eguchi and Miyanaga, for the purpose of saving time.

In addition, Kaufeld discloses a forward stopping control unit that stops facsimile-forwarding of the facsimile data converted by the converting unit when the facsimile data converted by the converting unit exceeds the forwarding size upper limit (It was disclosed above how the fax transmission attempts are ceased, which reads on claimed stops facsimile forwarding; once the counter exceeds the predetermined value. Similar limiting may be applied if the data size exceeds a storage capacity (forwarding size upper limit), as previously mentioned with regard to the last claim, in order to prevent errors and free up the system resources (such as transmission availability) for other processes or transmissions that may be completed. Transmission computer reads on claimed forward stopping control unit for reasons disclosed above.);

Although the previous disclosures did not distinctly disclose a reporting unit that prints a report of report of facsimile-forwarding failure when the facsimile-forwarding of the facsimile data was stopped by the forward stopping control unit, Kaufeld discloses a reporting unit that sends a report of facsimile-forwarding failure by an email to a sender of the email when the facsimile-forwarding of the facsimile-forwarding data was stopped by the forward stopping control unit (Column 9, lines 9-20, fig. 8c, disclose that once no further attempts at fax transmission are to be made, an email is sent back to the sender indicating that the facsimile transmission was not successfully transmitted. In addition, details as to why are included. All of this reads on claimed report of facsimile-forwarding failure. Transmission computer reads on claimed reporting unit for reasons disclosed above.) In a similar field of endeavor, Sekiguchi discloses a communication apparatus. Sekiguchi discloses how it was well known to print a report of transmission failure (retransmission error report, ¶140), rather than email it, as taught by Kaufeld. It would have been obvious to one of ordinary skill at the time the invention was made to provide a reporting unit that prints a report of report of facsimile-forwarding failure when the facsimile-forwarding of the facsimile data was stopped by the forward stopping control unit for the purpose of providing a hard copy (provides benefit at least in not having to worry about data corruption) and/or saving space in the electronic system.

Regarding claim 17, the claim is rejected based upon similar reasoning as applied above for claim 13.

22. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over the previous disclosures as applied to claim 13 above, and further in view of Okutomi et al. (US 6211972), hereinafter referred to as Okutomi.

Regarding claim 18, the claim inherits everything as applied above for claim 13. However, the previous disclosures fail to disclose limiting by number of pages. However, the examiner maintains that it was well known in the art to provide limiting by number of pages, as taught by Okutomi.

In a similar field of endeavor, Okutomi discloses an electronic mail converting apparatus for facsimile. In addition, Okutomi discloses a LAN controlling section that compares the number of fax sheets to be produced from an email with the maximum output number of sheets, as disclosed at column 6, lines 48-51 and 61-66. The maximum number of sheets the fax machine has to output reads on forwarding size upper limit based on a number of pages. The number of pages that would be transmitted corresponds to image data and thus, data size. If the maximum output number of sheets is less than the number of email pages, then the transmission is limited, as disclosed in column 6, lines 66-67 and column 7, lines 1-4 and 14-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previous disclosures by specifically providing limiting by number of pages, as taught by Okutomi, for the purpose of saving cost, as disclosed in column 7, lines 21-23.

23. Claims 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufeld in view of Eguchi, Miyanaga, and Okutomi.

Regarding claim 19, the claim reads an image communication apparatus for sending a facsimile data to a facsimile machine, the apparatus comprising (the system of Kaufeld is disclosed as capable of sending a facsimile to a facsimile machine (Kaufeld: col. 3, lines 35-42)):

an email receiving unit that receives an email (column 3, lines 31-36. The transmission computer reads on claimed email receiving unit and receives email.);

an analyzing unit that analyzes the email received by the email receiving unit (column 3, lines 35-42 discloses the transmission computer checking over the received email, reads on claimed analyzing) and obtains a destination of the email and a source of the email (column 3, lines 38-42, col. 6, lines 45-48, col. 7, lines 37-44, column 7, lines 13-18, col. 7, lines 55-57 at least inherently disclose “obtaining” the destination and source at least in order to verify the sender and/or to convert and forward the email/facsimile according to the intended destination.);

a registering unit that registers senders whose emails are permitted to be facsimile-forwarded (column 4, lines 58-65 disclose registering a user's email address and column 3, lines 36-38 disclose checking to see if there is a valid email address. Column 7, lines 43-51 disclose checking for a valid email address and stopping the flow for forwarding transmission if the sender's address is not valid. A computer corresponds with a registering unit. (figure 3, column 3, lines 44-46) column 10, lines 54-60 disclose that a user may register destination address(es) that may be registered as a name or name list.), receiver whose facsimile data is received and a facsimile-forwarding destination corresponding to the receiver (the system that receives a sent facsimile may

be called a receiver. Inherently, the receiver receives the facsimile data intended for them (whose facsimile data is received). The previous discussions have provided for and/or it is inherent that there be a facsimile forwarding destination corresponding to the receiver in order for facsimile forwarding to successfully occur as intended (sent to/received by the receiver) and/or disclosed by Kaufeld. col. 10, lines 54-60 disclose that names may be registered for destinations. From the disclosure, it would have been at least obvious to one of ordinary skill in the art to provide that the sender may refer in the email to registered name for sending for the purpose of allowing for greater flexibility (as opposed to only for a name list) and/or control. The system would be capable of having the name be the receiver whose facsimile data is received. The disclosure discussed the names/name lists register corresponding facsimile numbers.)

a determining unit that determines whether the source of the email analyzed by the analyzing unit is a sender registered by the registering unit (Transmission computer reads on claimed determining unit. It was disclosed above how the email address of the source is checked to be valid (sender matches source), and acted upon accordingly (fig. 8a)) and the destination of the email is the receiver registered by the registering unit (previous discussions and col. 10, lines 54-60 allow for the name to be the receiver registered and the destination of the email);

a converting unit that converts the email into the facsimile data, the facsimile data including an image data to be transferred to the facsimile machine, when the source of the email is a sender registered by the registering unit (column 7, lines 13-18, column 3, lines 38-42 disclose that the email is converted to a facsimile from the email and the

facsimile is automatically generated and originated from information in the email. Fig. 8a-8b show that in order for the email to be converted to fax, the email sender must have a valid account (source match up to sender). Transmission computer reads on claimed converting unit. Facsimile data is in the conventional manner is sent as image data. Col.8, lines 52-54 discloses the conversion of email into facsimile image data for transmission.) and the destination of the email is the receiver registered by the registering unit (it has already been discussed how the conversion occurs when the sender and source match up. The case where additionally the destination of the email matches the receiver registered by the registering unit would be satisfied by the previous limitation being satisfied (having the receiver/destination match would not preclude conversion).);

a setting unit that sets an upper limit for facsimile-forwarding the email (column 8, lines 57-59 discloses the use of a transmit counter. Column 9, lines 9-20 disclose that once the counter exceeds a predetermined number, which reads on claimed upper limit; the attempts to fax-forward will cease. Fig 8c. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37) and thus, reads on claimed setting unit.);

and a forwarding control unit that conducts facsimile-forwarding of the facsimile data converted by the converting unit to the facsimile-forwarding destination corresponding to the receiver registered by the registering unit when the facsimile data converted by the converting unit does not exceed the upper limit set by the setting unit (The transmission computer performs the above and thus, reads on claimed forwarding control unit. Fig. 8c shows the attempt of fax transmission for the process described

previously. Fig. 8c shows the fax transmission allowed to proceed if the counter is below the predetermined number, which reads on claimed does not exceed the upper limit. This and the previous disclosures read on preceding limitation. It was disclosed above how the user may register destination addresses for receipt of a facsimile transmission. It was also previously discussed and/or disclosed at col. 10, lines 54-60 how a receiver name may be registered and a corresponding facsimile telephone number would be used for transmission.)

In addition, Kaufeld fails to disclose an upper limit for transmission being a forwarding size limit of facsimile data.

In a similar field of endeavor, Eguchi discloses a facsimile server, electronic mail device, and communication method. The facsimile server is typical for reception of faxes and allows for advance reception of faxes. Sending through a fax server would have been obvious to allow for advance storage, which would save time and allow for greater convenience and management. However, the storage size for holding the fax data is limited (col. 1, 26-31). Considering this issue, Eguchi discloses data size as a forwarding size upper limit of facsimile data (Eguchi discloses a RAM 21, which the capacity of is a designated value, which reads on claimed upper limit based on a data size of data; as disclosed at Figure 2 and column 4, line 15, and column 5, line 2-4. Eguchi discloses the when the data size for transmission is larger than the designated value, the facsimile server 2 does not receive the electronic mail from the electronic mail box, hence preventing transmission, as opposed to when the data size is smaller and

the electronic mail is received as usual, thereby allowing fax transmission, as disclosed at Figure 2 and column 5, lines 4-7, lines 11-16, 22-37.)

Kaufeld disclosed being able to compare an instance (counter value, for example) against a limit (predetermined value (col. 9, lines 6-67)). Based on whether the limit is exceeded, the fax is allowed to proceed or not. Using this same methodology, a limit could similarly be set based on data size, as taught by Eguchi.

However, Eguchi has taught a receiving side checking the initial size of data to be sent. Though the data may be in email format, the system still shows how the data size is able to be compared for fax storage. However, Eguchi did not distinctly show the sending side checking. Though this would be an obvious connection to have a similar process run by the sending side rather than the receiving side accordingly, the examiner provides a reference that shows the idea of a sending side checking, in order to provide further support.

In a similar field of endeavor, Miyanaga discloses a communication control method and system. Miyanaga discloses at col. 1, lines 63-67, col. 2, lines 1-3 that it is determined whether the transmission data amount of image data to be sent to a server from a communication apparatus exceeds the limit capacity of the server before the image data is sent, and that processing (limiting) is performed when the image data exceeds the limit capacity of the server. Though Miyanaga discloses the scenario with respect to email, the difference with respect to transmission of facsimile data would be insubstantial. In addition, the image data that is checked is the image data from a converted facsimile (col. 3, lines 31-34). The idea of checking reception capacity before

transmission could be applied. It would have been obvious to modify the current system by allowing for Kaufeld to check fax server capacity for limiting (Eguchi), but to check before sending (Miyanaga) in order to save a lot of time for the image transmission (col. 1, lines 61-62) that might occur if the data is sent, but not able to be fully received.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaufeld by specifically providing the upper limit being a forwarding size limit of facsimile data, as taught by Eguchi and Miyanaga, for the purpose of saving time.

For further support, Okutomi discloses a saved correspondence table that may correspond email addresses (may be names/receivers as stored in the correspondence table) to facsimile numbers. Fig. 6, col. 2, lines 25-26, col. 3, lines 18-57 discloses how facsimile data may be converted to email and transmitted by corresponding the facsimile destination to the destination email address. The abstract specifies that the converting may work in the reverse (vice versa) by converting email to facsimile in a similar fashion.

Therefore, it would have been at least obvious to one of ordinary skill in the art at the time the invention was made to modify the previous disclosures by specifically providing having a receiver registered whose facsimile data is received and a facsimile-forwarding destination corresponding to the receiver, determining whether the destination of the email is the receiver registered by the registering unit, forwarding to the facsimile-forwarding destination corresponding to the receiver registered by the

registering unit , as taught by Okutomi, for the purpose of not allowing other greater convenience and/or control.

Regarding claim 20, this claim inherits everything as applied above from claim 19. (col. 7, lines 46-50. As the sender sends from an email address, it would at least have been obvious to send the message back to the user by way of email for the purpose of convenience.) In addition, Kaufeld discloses a forward stopping control unit that stops facsimile-forwarding of the facsimile data converted by the converting unit when the facsimile data converted by the converting unit exceeds the forwarding size upper limit (It was disclosed above how the fax transmission attempts are ceased, which reads on claimed stops facsimile forwarding; once the counter exceeds the predetermined value. Similar limiting may be applied if the data size exceeds a storage capacity (forwarding size upper limit), as previously mentioned with regard to the last claim, in order to prevent errors and free up the system resources (such as transmission availability) for other processes or transmissions that may be completed. Transmission computer reads on claimed forward stopping control unit for reasons disclosed above.); and a reporting unit that sends a report of facsimile-forwarding failure by an email to a sender of the email when the facsimile-forwarding of the facsimile-forwarding data was stopped by the forward stopping control unit (Column 9, lines 9-20, fig. 8c, disclose that once no further attempts at fax transmission are to be made, an email is sent back to the sender indicating that the facsimile transmission was not successfully transmitted. In addition, details as to why are included. All of this reads on claimed report of

facsimile-forwarding failure. Transmission computer reads on claimed reporting unit for reasons disclosed above.)

Regarding claim 21, this claim inherits everything as applied above from claim 19. However, the previous disclosures did not distinctly disclose a splitting unit that splits facsimile data into a plurality of the facsimile data; and a split forwarding unit that forwards the plurality of the facsimile data split by the splitting unit to the facsimile destination one after another.

Miyanaga discloses that when the transmission data amount exceeds the capacity (forwarding size upper limit), that the image data to be sent is divided (split) and each divided part is sent one by one so that the amount of data for a single transmission is reduced (col. 9, lines 32-38).

In addition, limiting taught by Eguchi, who taught limiting by capacity, allows for division of fax data, in order to allow for the whole fax to be sent while still working within the confines of the capacity limit (Eguchi, col. 5, lines 50-55).

The splitting and forwarding may be done when a limit is exceeded, like a capacity limit (forwarding size upper limit), so that a disconnection or some other error might be able to be avoided and better success afforded. Kaufeld previously taught converting. Kaufeld previously taught facsimile-forwarding. Facsimile-forwarded data is facsimile data. The systems of Eguchi and/or Miyanaga that provide for the splitting and sending of the data in conjunction with the previous disclosures, such as of Kaufeld, may read upon claimed splitting unit and split forwarding unit.

Regarding claim 23, this claim inherits everything as applied above from claim 19. In addition, claim 23 is rejected based upon similar reasoning as applied above for claim 17.

Regarding claim 24, this claim inherits everything as applied above from claim 19. In addition, claim 24 is rejected based upon similar reasoning as applied above for claim 18.

Regarding claim 25, Kaufeld discloses an email receiving unit that receives an email (column 3, lines 31-36. The transmission computer reads on claimed email receiving unit and receives email.) and obtains a destination of the email, a source of the email, and a facsimile-forwarding destination (column 3, lines 38-42, col. 6, lines 45-48, col. 7, lines 37-44, column 7, lines 13-18, col. 7, lines 55-57 at least inherently disclose “obtaining” the destination and source at least in order to verify the sender and/or to convert and forward the email/facsimile according to the intended destination. In order for the email/facsimile to be forwarded to the facsimile destination, inherently, a facsimile-forwarding destination must be obtained as well.);

an analyzing unit that analyzes the email received by the email receiving unit (column 3, lines 35-42 discloses the transmission computer checking over the received email, reads on claimed analyzing);

a registering unit that registers a sender whose email is permitted to be facsimile-forwarded (column 4, lines 58-65 disclose registering a user's email address and column 3, lines 36-38 disclose checking to see if there is a valid email address. Column 7, lines 43-51 disclose checking for a valid email address and stopping the flow for

forwarding transmission if the sender's address is not valid. A computer corresponds with a registering unit. (figure 3, column 3, lines 44-46) column 10, lines 54-60 disclose that a user may register destination address(es) that may be registered as a name or name list.), receiver whose facsimile data is received and a facsimile-forwarding destination corresponding to the receiver (the system that receives a sent facsimile may be called a receiver. Inherently, the receiver receives the facsimile data intended for them (whose facsimile data is received). The previous discussions have provided for and/or it is inherent that there be a facsimile forwarding destination corresponding to the receiver in order for facsimile forwarding to successfully occur as intended (sent to/received by the receiver) and/or disclosed by Kaufeld. col. 10, lines 54-60 disclose that names may be registered for destinations. From the disclosure, it would have been at least obvious to one of ordinary skill in the art to provide that the sender may refer in the email to registered name for sending for the purpose of allowing for greater flexibility (as opposed to only for a name list) and/or control. The system would be capable of having the name be the receiver whose facsimile data is received. The disclosure discussed the names/name lists register corresponding facsimile numbers.)

a first determining unit that determines whether facsimile-forwarding destination is instructed by the email analyzed by the analyzing unit (column 6, lines 45-48 disclose addressing the email to the destination number of the facsimile machine to which the message is to be delivered. column 3, lines 35-42 disclosed the transmission computer sending the email to a facsimile machine. column 7, lines 13-18 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated

and originated from information in the email. Figures 4 & 6 disclose the fax number from the email used for the received fax sending. Transmission computer does the converting and analyzing, thus reading on the determining unit in the process in order to glean the fax number. As previously discussed, inherently, there must be a determination whether a facsimile-forwarding destination in “instructed” by the email in order for the email data to be facsimile converted and facsimile forwarded to an intended destination of the sender of the email.);

    a second determining unit that determines whether the destination of the email analyzed by the analyzing unit is the receiver registered by the registering unit (Transmission computer reads on claimed determining unit. Previous discussions and col. 10, lines 54-60 allow for the name to be the receiver registered and the destination of the email);

    a converting unit that converts the email into the facsimile data, the facsimile data including an image data to be transferred to the facsimile machine, if the determining unit determines that the facsimile-forwarding destination is instructed or when the second determining unit determines that the destination of the email is the receiver (column 7, lines 13-18 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Figures 4 & 6 disclose the fax number from the email used for the received fax sending. Previously disclosed, column 3, lines 38-42, the transmission computer, reading on claimed converting unit, converts the email into a fax and sends the email to the fax number instructed in the email. Facsimile data is in the conventional manner is

sent as image data. Col.8, lines 52-54 discloses the conversion of email into facsimile image data for transmission. Transmission computer reads on claimed converting unit. It was previously discussed that inherently, a facsimile-forwarding destination must be “instructed” in order for the facsimile to get there. It was discussed how the email was converted into facsimile and facsimile forwarded when the facsimile forwarding destination is instructed. In addition, if the destination is determined the receiver, as previously discussed, it is for the facsimile forwarding. Col. 10, lines 54-60 and the previous discussions discuss the names corresponding with facsimile numbers and that that the email is sent in order to specify the name as the destination/receiver of the email/facsimile data. Thus, the conversion would occur when the second determining unit determines that the destination of the email is the receiver.)

a setting unit that sets an upper limit for conducting facsimile-forwarding email (column 8, lines 57-59 discloses the use of a transmit counter. Column 9, lines 9-20 disclose that once the counter exceeds a predetermined number, which reads on claimed upper limit; the attempts to fax-forward will cease. Fig 8c. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37) and thus, reads on claimed setting unit.);

Kaufeld discloses a selection unit that selects the facsimile-forwarding destination specified by the facsimile-forwarding instruction when the first determining unit determines that the facsimile-forwarding destination is instructed by the email (It was previously discussed how inherently there must be a facsimile-forwarding destination instructed in order for successful facsimile-forwarding to occur. It was

discussed how the email may instruct a facsimile forwarding destination, by entering a to address that instructs a facsimile destination. For example, a facsimile number may be read out from the to address or may be instructed by correlated a destination name from the email with a facsimile number.) and selects the facsimile-forwarding destination corresponding to the receiver registered by the registering unit when the second determining unit determines that the destination of the email is the receiver registered by the registering unit (It was also disclosed above (and at column 10, lines 54-60 and column 7, lines 13-18, column 3, lines 38-42 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email.) how the user may alternatively refer to a stored (registered) destination or destination list by name. The transmission computer reads on claimed selection unit, as it performs the processes of receiving, processing and transmitting the email/facsimiles as has been discussed previously. It has been previously discussed how it is determined whether the destination matches the receiver/name. Thus, in that case, the corresponding facsimile number destination would be used.) (Please note the discussion under the claim rejections section above.); and a forwarding control unit that conducts facsimile-forwarding of the facsimile data converted by the converting unit to the facsimile-forwarding destination selected by the selection unit when the facsimile data converted by the converting unit does not exceed the upper limit set by the setting unit ((The transmission computer performs the above and thus, reads on claimed forwarding control unit. Fig. 8c shows the attempt of fax transmission for the process described previously. Fig. 8c shows the fax

transmission allowed to proceed if the counter is below the predetermined number, which reads on claimed does not exceed the upper limit. This and the previous disclosures read on preceding limitation. It was disclosed above how the user may register destination addresses for receipt of a facsimile transmission. The discussion of transmission allotted by the selection unit is also disclosed above.).

In addition, Kaufeld fails to disclose an upper limit for transmission being a forwarding size limit of facsimile data.

In a similar field of endeavor, Eguchi discloses a facsimile server, electronic mail device, and communication method. The facsimile server is typical for reception of faxes and allows for advance reception of faxes. Sending through a fax server would have been obvious to allow for advance storage, which would save time and allow for greater convenience and management. However, the storage size for holding the fax data is limited (col. 1, 26-31). Considering this issue, Eguchi discloses data size as a forwarding size upper limit of facsimile data (Eguchi discloses a RAM 21, which the capacity of is a designated value, which reads on claimed upper limit based on a data size of data; as disclosed at Figure 2 and column 4, line 15, and column 5, line 2-4. Eguchi discloses the when the data size for transmission is larger than the designated value, the facsimile server 2 does not receive the electronic mail from the electronic mail box, hence preventing transmission, as opposed to when the data size is smaller and the electronic mail is received as usual, thereby allowing fax transmission, as disclosed at Figure 2 and column 5, lines 4-7, lines 11-16, 22-37.)

Kaufeld disclosed being able to compare an instance (counter value, for example) against a limit (predetermined value (col. 9, lines 6-67)). Based on whether the limit is exceeded, the fax is allowed to proceed or not. Using this same methodology, a limit could similarly be set based on data size, as taught by Eguchi.

However, Eguchi has taught a receiving side checking the initial size of data to be sent. Though the data may be in email format, the system still shows how the data size is able to be compared for fax storage. However, Eguchi did not distinctly show the sending side checking. Though this would be an obvious connection to have a similar process run by the sending side rather than the receiving side accordingly, the examiner provides a reference that shows the idea of a sending side checking, in order to provide further support.

In a similar field of endeavor, Miyanaga discloses a communication control method and system. Miyanaga discloses at col. 1, lines 63-67, col. 2, lines 1-3 that it is determined whether the transmission data amount of image data to be sent to a server from a communication apparatus exceeds the limit capacity of the server before the image data is sent, and that processing (limiting) is performed when the image data exceeds the limit capacity of the server. Though Miyanaga discloses the scenario with respect to email, the difference with respect to transmission of facsimile data would be insubstantial. In addition, the image data that is checked is the image data from a converted facsimile (col. 3, lines 31-34). The idea of checking reception capacity before transmission could be applied. It would have been obvious to modify the current system by allowing for Kaufeld to check fax server capacity for limiting (Eguchi), but to check

before sending (Miyanaga) in order to save a lot of time for the image transmission (col. 1, lines 61-62) that might occur if the data is sent, but not able to be fully received.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaufeld by specifically providing the upper limit being a forwarding size limit of facsimile data, as taught by Eguchi and Miyanaga, for the purpose of saving time.

For further support, Okutomi discloses a saved correspondence table that may correspond email addresses (may be names/receivers as stored in the correspondence table) to facsimile numbers. Fig. 6, col. 2, lines 25-26, col. 3, lines 18-57 discloses how facsimile data may be converted to email and transmitted by corresponding the facsimile destination to the destination email address. The abstract specifies that the converting may work in the reverse (vice versa) by converting email to facsimile in a similar fashion.

Therefore, it would have been at least obvious to one of ordinary skill in the art at the time the invention was made to modify the previous disclosures by specifically providing having a receiver registered whose facsimile data is received and a facsimile-forwarding destination corresponding to the receiver, determining whether the destination of the email is the receiver registered by the registering unit, forwarding to the facsimile-forwarding destination corresponding to the receiver registered by the registering unit, as taught by Okutomi, for the purpose of not allowing other greater convenience and/or control.

24. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the previous disclosures as applied to claim 19, and further in view of Misawa et al. (US 6771382), hereinafter referred to as Misawa; and Matsumoto et al. (US 6373598), hereinafter referred to as Matsumoto.

Regarding claim 22, this claim inherits everything as applied above from claim 19. For the purposes of the claim, the forwarding size upper limit will be redefined for claim 22. It has previously been discussed how the size of a fax to be transmitted may be compared against a reference value (such as the amount of available storage for Eguchi.) However as has not been previously discussed, Misawa points out that communications over a network (such as to send a fax to a relay device 34 in Kaufeld) are subject to limitations in that the amount of information (information capacity) to be processed in a unit time is limited to a certain value (col. 1, lines 50-53). Misawa goes on to explain at col. 4, lines 59-67 that certain times of day correspond to different information capacity limitations. Thus, as size comparison to a reference has been taught, and as Kaufeld has taught waiting a predetermined period of time to resend (col. 9, lines 4-9), it would have been obvious to consider the information capacity limitation against the data size, and if the data size exceeded the information capacity (forwarding size upper limit), to resend at a later time when the information capacity might increase. This provides for greater system flexibility, robustness, and success. In addition, Kaufeld disclosed that if an attempt to send fails and that the transmit counter has not exceeded the predetermined value, the system waits a predetermined period of time in order to attempt to send the fax again (column 9, lines 4-9). However, as the time limit

acts a remedy to initial failures to send, it would have been obvious to one of ordinary skill in the art at the time the invention was made to wait the predetermined period of time for the purpose of using the wait time as the solution to the size limit being exceeded, and allow a chance for a greater capacity to be available in order to see if delaying the transmission will solve the problem. This provides for greater system simplicity. Further, though Kaufeld discloses that the predetermined amount of time could be 5 to 10 minutes, it would of course be obvious to set to a different amount of time for the purpose of providing greater system flexibility. However, Matsumoto discloses being able to schedule facsimile transmission at a specific time or after a certain period of time has passed (col. 1, lines 23-27, col. 1, lines 48-53). Thus, the time may be programmed so that a different delay that would correspond with a time of higher information capacity may be set. This would provide for greater system flexibility, robustness, convenience, and success. The transmission computer of Kaufeld/fax machine mentioned by Matsumoto may read on claimed specifying unit and time-specified forwarding control unit. If the facsimile data is not forwarded until a specific time when the limit has been exceeded; inherently, the facsimile-forwarding has been suspended until the time specified. Data amount of facsimile data is covered by the scope of the discussion.

25. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over the previous disclosures as applied to claim 25 above, and further in view of Ray (US 2004/0128207).

Regarding claim 26, the previous disclosures disclose everything as applied above for claim 25. In addition, Kaufeld and the previous disclosure of Okutomi disclose a third determining unit that determines whether or not the facsimile-forwarding by the forwarding control unit was successful (column 8, lines 57-59 discloses the use of a transmit counter. Column 9, lines 9-20 disclose that once the counter exceeds a predetermined number, which reads on claimed upper limit; the attempts to fax-forward will cease. Fig 8c. Thus, when the transmit counter limit has been exceeded the system knows that the transmission has been unsuccessful. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37) and thus, reads on claimed third determining unit.);

a fourth determining unit that determines whether the facsimile-forwarding destination selected by the selection unit is at least one of the facsimile-forwarding destination specified by the facsimile-forwarding instruction of the email and the facsimile-forwarding destination corresponding to the receiver registered by the registering unit (It has been disclosed previously and at col. 7, lines 17-18, col. 6, lines 45-48, col. 3. lines 32-41 how Kaufeld discloses being able to extract a specific destination address from an email, that instructs a facsimile destination for forwarding, which may read on claimed facsimile-forwarding destination specified by the facsimile-forwarding instruction; and how Kaufeld shows referencing a stored destination through a name or name list that is corresponded as taught by Okutomi, which may read on claimed destination corresponding to receiver registered by the registering unit. Therefore, Kaufeld discloses the two options working alternatively, and the system

being able to determine when a name is referring to a registered address(es), which reads on claimed determines. The transmission computer performs the functions of converting, transmitting, etc. as discussed previously and thus, reads on claimed fourth determining unit.); and a reporting unit that sends a report of facsimile-forwarding failure by an email to the sender of the email if the third determining unit determines that the facsimile-forwarding was not successful and the fourth determining unit determines that the facsimile-forwarding destination selected by the selection unit is specified by the facsimile-forwarding instruction of the email (column 9, lines 9-20 disclose sending an email back to the sender reporting that the facsimile transmission was unsuccessful and details as to why. Fig. 4, column 7, lines 43-44 disclose that the figs. 8a-8c, in which the previous disclosure is contained, are run through for an example of figure 4, where the instruction is set in the to line of the email, which reads on claimed facsimile-forwarding destination specified by the facsimile-forwarding instruction. Transmission computer reads on claimed reporting unit.),

However, the previous disclosures fail to disclose deleting the forwarding data when there is a transmission failure. However, the examiner maintains that it was well known in the art to provide deleting the forwarding data when there is a transmission failure, as taught by Eguchi.

In a similar field of endeavor, Eguchi discloses a facsimile server, electronic mail device, and communication method. In addition, Eguchi discloses deleting the forwarding data when there is a transmission failure (Eguchi discloses a size limit for forwarding of an email. If the email size is too big, the user may select not to receive

the item, to return a message to the sender, or forward it to a destination. If the setting is on return or forward, the memory where the message is received is cleared and the email is deleted from the electronic mail box (column 5, lines 11-41, 18-22, 32-34, & 39-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previous disclosures by specifically providing deleting the forwarding data when there is a transmission failure, as taught by Eguchi, for the purpose of freeing up space in order to allow more messages to come in that might be able to be transmitted.

Kaufeld has taught previously converting email data to facsimile data by the time that the transmission is found to be unsuccessful. Therefore, the combination would read on claimed deletes the facsimile-forwarding data converted by the converting unit. In addition, the previous disclosures did not distinctly disclose saving an item for transmission and sending a facsimile report that it was saved (an accumulation report) to the facsimile-forwarding destination corresponding to the receiver registered by the registering unit (see 112 assumption above) by facsimile if the third determining unit determines that the facsimile-forwarding was not successful and the fourth determining unit determines that the facsimile-forwarding destination selected by the selection unit is the facsimile-forwarding destination corresponding to the receiver. However, the examiner maintains that it was well known in the art to provide saving an item for transmission and sending a report that is was saved to a destination, as taught by Ray.

In a similar field of endeavor, Ray discloses systems and methods for providing item delivery notification. In addition, Ray discloses saving an item for transmission and sending a facsimile report that it was saved to a destination (Ray discloses a system for notifying recipients and/or senders about the transmission process of a package, for example. Ray discloses sending a notification, which reads on claimed; reporting that an item was not deliverable (as in the package was too big for the mailbox) and that it is being saved for the recipient available to be picked up at a central location, like a post office (¶ 36, ¶ 38), which reads on saving the item that is trying to be transmitted and sending a report that is was saved to a destination. In addition, Ray discloses communication with the recipient over a communications system, like the internet (¶ 23, 24). The communication to notify the recipient may take place by email or by facsimile, for example (¶ 24), by a facsimile to a facsimile destination.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previous disclosures by specifically providing saving an item for transmission and sending a facsimile report that it was saved to a destination, as taught by Ray, for the purpose of allowing a recipient to the know the transmission status of their facsimile delivery and providing more overall system (including the receiver, in this case) awareness.

In the case that a correspondence table/name from a name list is used as may correspond to the claimed “fourth determining unit determines that the facsimile-forwarding destination selected by the selection unit is the facsimile-forwarding destination corresponding to the receiver,” it would be obvious to one of ordinary skill in

the art to send a fax to the fax destination(s) specified by the corresponding name(s) in a name/correspondence list. The sender who sent an email for fax-forwarding to a name list would not want all of the error messages for the name particular names from the name list that had errors to come back to him/her. It would be easier to have the individuals take care of their own facsimile information if they would like it, rather than one individual for all. If the sender of the email specifies a particular fax destination by email, this may be taken as more important and/or specific, and the faster response and resending capable by the sender of the email would have made such a situation more prone to not forwarding the fax to the user and doing the first-claimed process of error response.

Kaufeld has taught previously converting email data to facsimile data by the time that the transmission is found to be unsuccessful. Therefore, the combination would read on claimed saves the facsimile data converted by the converting unit.

***Response to Arguments***

26. Applicant's arguments filed 11/26/08 have been fully considered but they are not persuasive.

Regarding the discussion for 112 1<sup>st</sup> rejection of claim 18 (and similarly-limited and dependent claims), the applicant cited a portion of the specification in order to attempt to properly traverse the prior rejection. However, this cited portion mentions a "forwarding upper limit," not a "forwarding size upper limit" as claimed, and previously specifically amended to differentiate from "upper limit."

The applicant was unclear where support for the fact that forwarding size upper limit is a separate feature from the forwarding page upper limit beyond the statement made by the applicant during the personal interview noted. In reply, the examiner supplies examples from the specification at least pg. 5, lines 28-31 and pg. 6, lines 2-5 for benefit of the applicant. From the referenced portions, it may be seen how the forwarding size upper limit and the forwarding page upper limit are separate feature, as requested by the applicant (bottom of pg. 10).

Regarding the discussion for claim 13 (and similarly-limited and dependent claims), the substance of the applicant's proposal regarding the claim(s) surrounds the idea that the references did not provide a forward stopping control unit that stops facsimile-forwarding of the facsimile data converted by the converting unit when the facsimile data converted by the converting unit exceeds the forwarding size upper limit; and a reporting unit that prints a report of facsimile-forwarding failure when the facsimile-forwarding of the facsimile data was stopped by the forward stopping control unit. However, the examiner respectfully disagrees. The applicant provided interpretations from some of the references; however, it is not clear how these particular interpretations preclude the references and the corresponding discussions provided in the rejection of claim 13 from rejecting the claimed language. The applicant seems to attempt culminate the interpreted choice pickings from the references in a statement that both Kaufeld and Eguchi disclose the forwarding of data occurring after a determination has been made in regard to whether the data exceeds a preset upper limit. It was first disclosed how Kaufeld provided for a setting unit that sets an upper limit for facsimile-

forwarding the email (column 8, lines 57-59 discloses the use of a transmit counter. Column 9, lines 9-20 disclose that once the counter exceeds a predetermined number, which reads on claimed upper limit; the attempts to fax-forward will cease. Fig 8c. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37) and thus, reads on claimed setting unit.). Then, it was discussed that though Kaufeld did not show the upper limit for transmission being a forwarding size limit of facsimile data, Eguchi provided that such a limitation was well known in the art. In a similar field of endeavor, Eguchi discloses a facsimile server, electronic mail device, and communication method. The facsimile server is typical for reception of faxes and allows for advance reception of faxes. Sending through a fax server would have been obvious to allow for advance storage, which would save time and allow for greater convenience and management. However, the storage size for holding the fax data is limited (col. 1, 26-31). Considering this issue, Eguchi discloses data size as a forwarding size upper limit of facsimile data (Eguchi discloses a RAM 21, which the capacity of is a designated value, which reads on claimed upper limit based on a data size of data; as disclosed at Figure 2 and column 4, line 15, and column 5, line 2-4. Eguchi discloses the when the data size for transmission is larger than the designated value, the facsimile server 2 does not receive the electronic mail from the electronic mail box, hence preventing transmission, as opposed to when the data size is smaller and the electronic mail is received as usual, thereby allowing fax transmission, as disclosed at Figure 2 and column 5, lines 4-7, lines 11-16, 22-37.) Kaufeld disclosed being able to compare an instance (counter value, for example) against a limit (predetermined value (col. 9, lines

6-67)). Based on whether the limit is exceeded, the fax is allowed to proceed or not.

Using this same methodology, a limit could similarly be set based on data size, as taught by Eguchi. This discussion taken in conjunction with the additional discussion provided for the rejection teaches against the applicant's summation. Thus, the extraneous interpretations discussed by the applicant do not preclude the discussion pertaining to the rejection of claim 1 by the references from being valid.

Regarding the discussion for claim 19 (and similarly-limited and dependent claims), the substance of the applicant's proposal regarding the claim(s) surrounds the idea that amended features were not provided by the previously-applied references. The issue is moot due to the fact that the amendments necessitated new grounds of rejection. However, the references do provide for the limitations in contention. An excerpt from the rejection discussion is provided. An analyzing unit that analyzes the email received by the email receiving unit (column 3, lines 35-42 discloses the transmission computer checking over the received email, reads on claimed analyzing) and obtains a destination of the email and a source of the email (column 3, lines 38-42, col. 6, lines 45-48, col. 7, lines 37-44, column 7, lines 13-18, col. 7, lines 55-57 at least inherently disclose "obtaining" the destination and source at least in order to verify the sender and/or to convert and forward the email/facsimile according to the intended destination.);

a registering unit that registers senders whose emails are permitted to be facsimile-forwarded (column 4, lines 58-65 disclose registering a user's email address and column 3, lines 36-38 disclose checking to see if there is a valid email address. Column

7, lines 43-51 disclose checking for a valid email address and stopping the flow for forwarding transmission if the sender's address is not valid. A computer corresponds with a registering unit. (figure 3, column 3, lines 44-46) column 10, lines 54-60 disclose that a user may register destination address(es) that may be registered as a name or name list.), receiver whose facsimile data is received and a facsimile-forwarding destination corresponding to the receiver (the system that receives a sent facsimile may be called a receiver. Inherently, the receiver receives the facsimile data intended for them (whose facsimile data is received). The previous discussions have provided for and/or it is inherent that there be a facsimile forwarding destination corresponding to the receiver in order for facsimile forwarding to successfully occur as intended (sent to/received by the receiver) and/or disclosed by Kaufeld. col. 10, lines 54-60 disclose that names may be registered for destinations. From the disclosure, it would have been at least obvious to one of ordinary skill in the art to provide that the sender may refer in the email to registered name for sending for the purpose of allowing for greater flexibility (as opposed to only for a name list) and/or control. The system would be capable of having the name be the receiver whose facsimile data is received. The disclosure discussed the names/name lists register corresponding facsimile numbers.)

a determining unit that determines whether the source of the email analyzed by the analyzing unit is a sender registered by the registering unit (Transmission computer reads on claimed determining unit. It was disclosed above how the email address of the source is checked to be valid (sender matches source), and acted upon accordingly (fig. 8a)) and the destination of the email is the receiver registered by the registering unit

(previous discussions and col. 10, lines 54-60 allow for the name to be the receiver registered and the destination of the email);

a converting unit that converts the email into the facsimile data, the facsimile data including an image data to be transferred to the facsimile machine, when the source of the email is a sender registered by the registering unit (column 7, lines 13-18, column 3, lines 38-42 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Fig. 8a-8b show that in order for the email to be converted to fax, the email sender must have a valid account (source match up to sender). Transmission computer reads on claimed converting unit. Facsimile data is in the conventional manner is sent as image data. Col.8, lines 52-54 discloses the conversion of email into facsimile image data for transmission.) and the destination of the email is the receiver registered by the registering unit (it has already been discussed how the conversion occurs when the sender and source match up. The case where additionally the destination of the email matches the receiver registered by the registering unit would be satisfied by the previous limitation being satisfied (having the receiver/destination match would not preclude conversion).)

Please see the full discussion for context/more information.

Regarding the discussion for claim 25 (and similarly-limited and dependent claims), the substance of the applicant's proposal regarding the claim(s) surrounds the idea that amended features were not provided by the previously-applied references. The issue is moot due to the fact that the amendments necessitated new grounds of

rejection. However, the references do provide for the limitations in contention. An excerpt from the rejection discussion is provided. An analyzing unit that analyzes the email received by the email receiving unit (column 3, lines 35-42 discloses the transmission computer checking over the received email, reads on claimed analyzing); a registering unit that registers a sender whose email is permitted to be facsimile-forwarded (column 4, lines 58-65 disclose registering a user's email address and column 3, lines 36-38 disclose checking to see if there is a valid email address. Column 7, lines 43-51 disclose checking for a valid email address and stopping the flow for forwarding transmission if the sender's address is not valid. A computer corresponds with a registering unit. (figure 3, column 3, lines 44-46) column 10, lines 54-60 disclose that a user may register destination address(es) that may be registered as a name or name list.), receiver whose facsimile data is received and a facsimile-forwarding destination corresponding to the receiver (the system that receives a sent facsimile may be called a receiver. Inherently, the receiver receives the facsimile data intended for them (whose facsimile data is received). The previous discussions have provided for and/or it is inherent that there be a facsimile forwarding destination corresponding to the receiver in order for facsimile forwarding to successfully occur as intended (sent to/received by the receiver) and/or disclosed by Kaufeld. col. 10, lines 54-60 disclose that names may be registered for destinations. From the disclosure, it would have been at least obvious to one of ordinary skill in the art to provide that the sender may refer in the email to registered name for sending for the purpose of allowing for greater flexibility (as opposed to only for a name list) and/or control. The system would be capable of

having the name be the receiver whose facsimile data is received. The disclosure discussed the names/name lists register corresponding facsimile numbers.)

a first determining unit that determines whether facsimile-forwarding destination is instructed by the email analyzed by the analyzing unit (column 6, lines 45-48 disclose addressing the email to the destination number of the facsimile machine to which the message is to be delivered. column 3, lines 35-42 disclosed the transmission computer sending the email to a facsimile machine. column 7, lines 13-18 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Figures 4 & 6 disclose the fax number from the email used for the received fax sending. Transmission computer does the converting and analyzing, thus reading on the determining unit in the process in order to glean the fax number. As previously discussed, inherently, there must be a determination whether a facsimile-forwarding destination in “instructed” by the email in order for the email data to be facsimile converted and facsimile forwarded to an intended destination of the sender of the email.);

a second determining unit that determines whether the destination of the email analyzed by the analyzing unit is the receiver registered by the registering unit (Transmission computer reads on claimed determining unit. Previous discussions and col. 10, lines 54-60 allow for the name to be the receiver registered and the destination of the email);

a converting unit that converts the email into the facsimile data, the facsimile data including an image data to be transferred to the facsimile machine, if the

determining unit determines that the facsimile-forwarding destination is instructed or when the second determining unit determines that the destination of the email is the receiver (column 7, lines 13-18 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Figures 4 & 6 disclose the fax number from the email used for the received fax sending. Previously disclosed, column 3, lines 38-42, the transmission computer, reading on claimed converting unit, converts the email into a fax and sends the email to the fax number instructed in the email. Facsimile data is in the conventional manner is sent as image data. Col.8, lines 52-54 discloses the conversion of email into facsimile image data for transmission. Transmission computer reads on claimed converting unit. It was previously discussed that inherently, a facsimile-forwarding destination must be “instructed” in order for the facsimile to get there. It was discussed how the email was converted into facsimile and facsimile forwarded when the facsimile forwarding destination is instructed. In addition, if the destination is determined the receiver, as previously discussed, it is for the facsimile forwarding. Col. 10, lines 54-60 and the previous discussions discuss the names corresponding with facsimile numbers and that that the email is sent in order to specify the name as the destination/receiver of the email/facsimile data. Thus, the conversion would occur when the second determining unit determines that the destination of the email is the receiver.)

Please see the full discussion for context/more information.

***Conclusion***

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM C. STOREY whose telephone number is (571)270-3576. The examiner can normally be reached on Monday - Friday Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Y. Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William C Storey/  
Examiner, Art Unit 2625

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